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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,008	07/13/2005	Francesco Matteucci	P08703US00/MP	8930
881 7590 05/03/2007 STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314			EXAMINER SINGH, SUNIL	
			ART UNIT 3673	PAPER NUMBER
			MAIL DATE 05/03/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/542,008

Applicant(s)

MATTEUCCI, FRANCESCO

Examiner

Sunil Singh

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/13/06</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: page 10, "through 9 0" is incorrect. Appropriate correction is required.
2. The abstract of the disclosure is objected to because "means" and "said" should be omitted. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.

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- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "433" has been used to designate both tie-rods and pin (see page 8 of specification). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are replete with indefiniteness and antecedent basis errors that are too numerous to mention each one specifically. Applicant should carefully review all claims and make appropriate corrections. Some examples are noted below:

Claim 1 line 4, "the said line" is confusing.

Claim 1 calls removing pipelines at line 1; however at line 3 pipeline is recited; it is unclear how they are related.

Claim 2 line 7, "said means" is recited; however, it is unclear what "means" it is referring back to.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1,2 are rejected under 35 U.S.C. 102(b) as being anticipated by Abdallah et al. (US 4445804).

Abdallah discloses a method for cutting and removing underwater pipelines, comprising the following steps:

- a) determining (38) the position of the underwater pipeline (18) to be removed;
- b) positioning, on the said line, guiding means (26,30) for positioning cutting means (48,50) and means (54,70) for recovering the cut pipe sections, said guiding means being able to be repositioned along said line (18) and being stably connected to a boat (10) intended to collect the recovered sections;
- c) guided positioning of the cutting means and guided positioning of the recovery means (3);
- d) cutting of the pipe section of predetermined length;
- e) removal of said section by means of said recovery means;
- f) transfer of the pipe section recovered by said recovery means to said boat (see col. 9);
- g) repositioning of the guiding means along the remaining line portion to be removed and repetition of the preceding steps c) to f) until the underwater pipeline (40) has been completely removed.

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9. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by either Gray et al. or Scodino et al. (US 5044827 or 4444528).

Gray et al. and Scodino et al. both disclose an apparatus comprising: means (50,23) for cutting said underwater pipelines, means (60,51) for recovering the cut sections of said lines, guiding means (46,5) for positioning said cutting means and recovery means, means (16) for suspending said guiding means, cutting means and recovery means, and means for transferring the recovered pipe sections to the loading compartment of a boat, said means being located on a suitable support comprising a plate arranged on the deck of said boat opposite an opening formed in the stern wall thereof.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-6, 14-16, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abdallah et al. in view of British document '648.

Abdallah et al. discloses the invention substantially as claimed. However, Abdallah et al. is silent about including a pivotable gantry means for manipulating the guide, cutting and recovery means. British document teaches a pivotable gantry means (see disclosure). It would have been considered obvious to one of ordinary skill in the art to

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modify Abdallah et al. to include the gantry means as taught by British document '648 in order to facilitate the maneuvering of the guide, cutting and recovery means.

12. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abdallah et al. in view of Wipo '059

Abdallah et al. discloses the invention substantially as claimed. However, Abdallah et al. is silent about the cutting means including a pulley/cable cutting means. Wipo '059 teaches a cutting means including a pulley/cable cutting means (4,104). It would have been considered obvious to one of ordinary skill in the art to modify Abdallah et al to substitute the cutting means as taught by Wipo for the cutting means disclosed by Abdallah et al. since it is a design choice to substitute equivalent parts for performing equivalent functions.

13. Claims 3-6, 14-16, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scodino et al. in view of British document '648.

Scodino et al. discloses the invention substantially as claimed. However, Scodino et al. is silent about including a pivotable gantry means for manipulating the guide, cutting and recovery means. British document teaches a pivotable gantry means (see disclosure). It would have been considered obvious to one of ordinary skill in the art to modify Scodino et al. to include the gantry means as taught by British document '648 in order to facilitate the maneuvering of the guide, cutting and recovery means.



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14. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scodino et al. in view of Wipo '059

Scodino et al. discloses the invention substantially as claimed. However, Scodino et al. is silent about the cutting means including a pulley/cable cutting means. Wipo '059 teaches a cutting means including a pulley/cable cutting means (4,104). It would have been considered obvious to one of ordinary skill in the art to modify Scodino et al to substitute the cutting means as taught by Wipo for the cutting means disclosed by Scodino et al. since it is a design choice to substitute equivalent parts for performing equivalent functions.

***Allowable Subject Matter***

15. Claims 7-13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

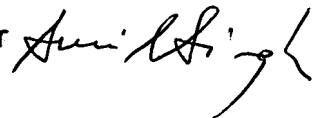
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (571) 272-7051. The examiner can normally be reached on Monday through Friday 10:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Engle Patricia can be reached on (571) 272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sunil Singh  
Primary Examiner  
Art Unit 3673



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4/27/07